

REMARKS

By this Amendment, Applicants have amended claims 1-13, 16-17, and 43 to more appropriately define the present invention, such that claims 1-63 remain pending in this application. Claims 1 and 43 have been amended to recite “computer-implemented” in the preamble.

In the Office Action, the Examiner rejected claims 1-21 and 43-63 under 35 U.S.C. §101 as being directed to non-statutory subject matter and rejected claims 1-63 under 35 U.S.C. § 102(e) as being anticipated by Patent Application Publication No. US 2002/0010686 (“Whitesage”). Applicants respectfully traverse these rejections for the following reasons.

Rejection Under 35 U.S.C. § 101

According to the Examiner, the recitations of claims 1-21 and 43-63 “fail to recite any technology within the claims” and “are not within the ‘technological art,’ because the claimed invention is not an operation being performed by a computer.” (OA at 5).

Applicants disagree. According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375. If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. See *State Street*, 149 F.3d at 1373, *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

The guidelines for examining computer-related inventions are set forth in M.P.E.P § 2106. Section II.A. of § 2106 states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101...Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection (internal citations omitted).

The Examiner has wholly failed to establish a *prima facie* showing that claims 1-21 and 43-63 are “abstract ideas.” The Examiner’s conclusory statements that the claims “fail to recite any technology” and are “not within the ‘technological art,’” are entirely unsupported and do not by themselves establish that the claims are “devoid of any limitation to a practical application in the technological arts,” as set forth in M.P.E.P. § 2106(II)(A). Nor has the Examiner “expressly stat[ed] how the language of the claims has been interpreted to support the rejection.” Because the Examiner fails to provide any evidence to support the allegations in the Office Action, the rejection of claims 1-21 and 43-63 under 35 U.S.C. § 101 should be withdrawn.

The Examiner’s failure to establish the required *prima facie* showing notwithstanding, claims 1-21 and 43-63 are statutory for at least following reasons. Claims 1-21 and 43-63 include recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application and are not abstract. Claim 1 recites, *inter alia*:

identifying, for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index . . .;

modifying the received purchasing data to include data representing the identified product; and

processing the modified purchasing data to reflect all purchase transactions concerning the identified product.

These steps produce useful, concrete, and tangible results. For example, identifying a product related to a purchase transaction is a useful, non-abstract result that facilitates modifying the received purchasing data to include data representing the identified product. In addition, processing the purchasing data “to reflect all purchase transactions concerning the identified product” is a useful, non-abstract result. Independent claim 43, although of different scope, is not abstract for at least reasons similar to those above for claim 1.

Moreover, whether or not the claims recite “an operation being performed by a computer within a computer” (OA at 5) is not dispositive of determining whether a claimed process is statutory. In fact, the Federal Circuit indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T*, F.3d at 1359. Even still, Applicants have amended claims 1 and 43 to define “computer-implemented” method and system, respectively.

For each of these reasons, claims 1-21 and 43-63 are drawn to useful, concrete, and tangible results, and are therefore not abstract but, rather, statutory under 35 U.S.C. § 101. Accordingly, Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 101.

Regarding the rejection under 35 U.S.C. §102(e)

Applicants respectfully traverse the rejection of claims 1-63 under 35 U.S.C. §102(e) as anticipated by *Whitesage*.

In order to properly establish that *Whitesage* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the claim." See M.P.E.P. § 2131. Here, *Whitesage* does not teach each and every element of the claims, and thus the Examiner's rejection under 35 U.S.C. § 102(e) is improper.

Claims 1, 22, and 43 recite, *inter alia*:

identifying, for each transaction, a product related to the transaction by comparing the received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product.

Whitesage, by contrast, is directed to managing purchasing contracts. The portions of *Whitesage* cited by the Examiner ([0066] to [0068]) relate to generating a purchasing contract. Here, *Whitesage* discloses creating an Entity Database storing information on the supplier and customer entities associated with the purchasing contract and creating a Contacts Database identifying each entity's employees assigned to the contract. See [0066]. The disclosed system also collects the contract terms and any historical transaction data for the same or similar products that are the subject of the contract. See [0068]. According to *Whitesage*, since the historical transaction data may not adequately identify the product units associated with each transaction, the system "individualizes the transaction data sets which are collected" by "deriving one or more individualized transactions from a parent transaction." *Id.* After converting the individualized transaction data sets into a standard format, they are then stored in a

Transaction Detail Database. *Id.* The disclosed system then uses this database to identify which transactions are applicable to the proposed contract at issue. See [0069].

Whitesage, therefore, does not disclose “identifying, for each transaction, a product related to the transaction” by “comparing . . . received purchasing data with product information stored in a product index, wherein the product information in the index associates at least a portion of the received purchasing data with a particular product,” as recited in claims 1, 22, and 43. *Whitesage* simply describes identifying individual transactions and comparing the individualized transactions with the proposed contract terms to determine which transactions are applicable to the particular contract. See [0069]. Any disclosure in *Whitesage* for “identifying . . . a product related to the transaction,” and doing so by using the claimed “product index,” is entirely lacking.

If the Examiner continues with this rejection, Applicants request that the Examiner more clearly identify the specific sections of *Whitesage* that are relied on for disclosing the elements of claims 1, 22, and 43. For example, while it is clear that *Whitesage* fails to disclose the claimed “product index,” it is unclear what disclosure of *Whitesage* the Examiner is relying on for disclosing this element in the first place.

For the above reasons, Applicants submit that claims 1, 22, and 43 are allowable and respectfully request that the Examiner withdraw the rejection of claims 1, 22, and 43 under 35 U.S.C. § 102(e). Dependent claims 2–21, 23–42, and 44–63 are also allowable at least by virtue of their respective dependence from allowable base claims 1, 22, and 43.

SUMMARY AND CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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